

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Confirmation No. : 9909

Appln. No. : 10/724,453

Applicant : James C. Peacock III

Filed : 11/28/2003

TC/A.U. : 3734

Examiner : Dowe, Katherine Marie

Docket No. : 19 53233-00007

Customer No. : 48423

Title : Medical Device with Porous Surface Containing Bioerodable Bioactive Composites and Related Methods

PETITION TO WITHDRAW FINALITY OF OFFICE ACTION

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby petitions for withdrawal of the finality of the Office action dated December 10, 2007.

The Office action dated December 10, 2007 was designated as "final." Item 11 of the Office action on page 9 stated that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL."

However, Applicant's response (dated November 18, 2007) to the final Office action (dated September 18, 2007) did not contain any amendments. Applicant pointed out in that response that Nakayama (US 2006/0036311) was an improper reference under 35 USC § 102(e). In the Office action dated December 10, 2007, the Examiner noted that Nakayama is not a proper 35 USC § 102(e) reference (Page 2, Item 4).

Under the present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by the applicant's amendment of the claims, nor based on information submitted in

an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). MPEP § 706.07(a)

The Examiner discovered and applied a new reference, O'Brien et al. (US 2005/0060021), in Office action dated 12/10/07 and made it final. Such action was not necessitated by the Applicant or Applicant's amendment of which there were none.

In the Advisory Action dated February 26, 2008, the Examiner asserted that although the Amendment filed on 11/19/07 did not necessitate a new ground of rejection the Amendment filed on 7/2/07 contains amendments necessitating new grounds of rejection.

Applicants submit that O'Brien (US 2005/00600021) appeared as a reference only after the determination that Nakayama (US 2006/0036311) was an improper reference for the first time in the Office action dated 12/10/07. The Examiner's use of O'Brien et al. was not necessitated by Applicants' amendment on 7/2/07. Even if this were the case, O'Brien et al. should have been included as a reference in the Office action issued (12/10/07) in response to Applicants' amendment on 7/2/07.

In view of the foregoing, Applicant petitions to withdraw the finality of the Office.

The Commissioner is authorized to charge any fee which may be required in connection with this action to deposit account No. 50-3207.

Respectfully submitted,

Dated: 13-March-2008

/Daniel S. Kim/
Daniel S. Kim
Registration No. 51877
CUSTOMER NUMBER: 45,200

KIRKPATRICK & LOCKHART PRESTON GATES ELLIS LLP
1900 Main Street, Suite 600
Irvine, California 92614-7319
Telephone: (949) 253-0900
Facsimile: (949) 253-0902